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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,774	05/25/2001	Timothy Wells	2620	5773

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EXAMINER

BAXTER, JESSICA R

ART UNIT PAPER NUMBER

3731

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 16

Application Number: 09/865,774
Filing Date: May 25, 2001
Appellant(s): WELLS ET AL.

Christopher G. Trainor
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 5, 2003.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-10 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,674,237	OTT	10-1997
5,928,154	SILBER et al.	07-1999

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1- 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,674,237 to Ott in view of U.S. Patent No. 5,928,154 to Silber et al.

Ott discloses a trocar assembly comprising an obturator (see FIG. 2 obturator 22), a sharpened tip (see FIG. 2 tip 24), and a hand grip (see FIG.2 handle 110). Ott discloses the claimed invention except for the cushioned member positioned on at least one contact surface of the hand grip. Silber teaches that a cushioned member is provided on the hand grip in order to enable the instrument's user to maintain control while applying minimal gripping force (see Column 3 lines 17-23). Although Silber discloses that the member is substantially non compressible (see Column 3 lines 17-19), Silber later discloses that the material used would have a low durometer and thus has a cushioning effect (see Column 3 lines 63-64). In addition, the preferred materials of the claimed invention such as Santoprene, silicone, and nitrile are specifically mentioned as being used to form the cushioned member (see Column 8 lines 28-60). It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a cushioned member to the hand grip of Ott's trocar assembly in order to enable the instrument's user to maintain control of the instrument while applying minimal gripping force.

Regarding claim 2, Silber discloses that the cushioned member is made from a thermoplastic elastomer (see Column 3 lines 63-64).

Regarding claims 3 and 10, Silber discloses that the cushioned member is over-molded onto the hand grip (see Column 4 lines 26-27).

Regarding claim 4, Silber discloses that the cushioned portion is formed from an elastomeric material (see Column 8 lines 28-60).

Regarding claims 5 and 6, Silber does not specifically disclose that the cushioned member is secured to a hand grip with an adhesive or by welding. Silber does suggest that the cushioned member may be secured to the hand grip by other methods. Silber discloses that adhesives are not used to attach the cushioned member to the hand grip (see Column 3 lines 53-58). However, Silber does specifically suggest that adhesives are a known way of permanently attaching things together. Silber chooses not to utilize adhesives since he considers them not to be on the same level of secured attachment as the mechanical interlocking that he prefers. A person skilled in the art would be able to select and utilize adhesives if he desired a lower level of secured attachment. Silber also discloses that many other techniques may be used in the art to secure the cushioned member to the hand grip. Silber specifically suggests coating, laminating, molding, and casting procedures (see Column 8 lines 23-27). Welding is another well known attachment technique that is equivalent to any of the methods suggested by Silber. It would have been obvious to one having ordinary skill in the art at the time the invention was made to secure the cushioned member to the hand grip since welding and applying adhesives are well known attachment techniques.

Regarding claim 7, Silber discloses that the cushioned member is formed from a slip-resistant material (see Column 3 lines 17-19).

Regarding claim 8, Silber discloses that the elastomeric material can be nitrile or silicon (see Column 8 lines 28-60).

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Regarding claim 9, Ott discloses that the hand grip may be formed of a thermoplastic material (Column 5 lines 29-33) and Silber discloses that the cushioned member is formed from an elastomeric material (see Column 8 lines 28-60).

(11) Response to Argument

Claims 1-10

Applicant argues “The cushioned member of Claim 1 differs greatly from the safety shield features of the Ott patent, which cover the sharpened tip of the obturator.” It is unclear how this argument is relevant. The safety shield of Ott has not been cited as meeting the limitation of a cushioned member.

Applicant argues that the Silber reference does not teach a cushioned member on at least one pressure contact surface. Applicant argues that the coating of Silber is “a substantially non-compressible, thin, rigid, elastomeric coating having a high coefficient of friction” and is thus not a cushioning member. The term “cushioning” is not defined in the specification as meaning compressible. *The American Heritage Dictionary of the English Language, Fourth Edition* defines cushioning as “something resilient used as a rest, support, or shock absorber” (see attached). The elastomeric material, by definition, is resilient and therefore must inherently provide a cushioning effect. In addition, the claim language and the specification do not indicate the thickness or the compressibility of the cushioning member. In addition, the term substantially implies that the material may be somewhat compressible. Silber teaches the use of a number of low durometer polymeric thermoplastic elastomers including Santoprene, nitrile and silicon (Column 8 lines 28-60). These materials are disclosed by the applicant as being used as a cushioning member (Page 4 lines 4-7). In addition, the applicant discloses that the cushioning member “can be from about 10 to about 80, but is preferably between about 20 to about 50, and more preferably about 40 ”(Page 5 lines 7-9).

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Silber teaches a specific embodiment of the coating wherein the durometer of the material is 47 (Column 8 lines 7-16). This durometer falls within the applicants preferred range. Silber teaches the same materials and the same material hardness. Therefore, the coating of Silber inherently functions as a cushioning member since the coating is made out of the same materials with low durometers.

Applicant argues that the Silber "coating layer would not lessen the impact on a surgeon's hand while inserting a trocar through a patient's tissue" since the resulting device would have "a thin rigid non-compressible coating layer over a handle". However, the coating on the handle would be *substantially* non-compressible, *substantially* thin, and *substantially* rigid. The term *substantially* implies that the coating may be slightly flexible and slightly compressible. Therefore, the coating would inherently provide a cushioning effect since it is only *substantially* non-compressible and *substantially* rigid and is made out of the same materials having the same hardness as those disclosed by the applicant. The applicant's claims and specification give no indication of the thickness of the cushioning member. Therefore, the coating of Silber inherently provides a cushioning effect.

Applicant argues "the safety shield and the safety lock mechanism of Ott does not require, or suggest, a grip layer of a thin, rigid elastomeric coating." This argument is unclear since the *substantially* thin, *substantially* rigid elastomeric coating is applied to the hand grip of the trocar and not the safety shield and safety lock mechanism. In addition, it is unclear what is meant by the opposing goals. Ott and Silber both disclose surgical instruments gripped in the hand of a surgeon. The coating of Silber was applied to the trocar of Ott in order to allow the surgeon to maintain control over the instrument while using minimal gripping force. Ott and Silber both teach hand held surgical instruments, therefore, the coating of Silber may be applied to the hand grip of Ott in order to enable the instrument's user to maintain control of the instrument while applying minimal gripping force.

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In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Silber reference provides motivation to apply the Silber coating to the trocar of Ott in order to enable the instrument's user to maintain control of the instrument while applying minimal gripping force.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Jessica R Baxter
Examiner
Art Unit 3731

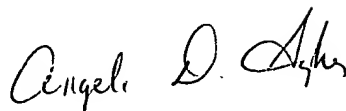
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November 28, 2003

Conferees


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